No. 341

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CHARLES ELMORE CROPLEY
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1950

FORREST H. SMITH, *et al.*,

Petitioners,

vs.

FLORENCE-MAYO NUWAY COMPANY, *et al.*,

Respondents.

PETITION FOR WRIT OF CERTIORARI AND BRIEF IN SUPPORT THEREOF

CLARENCE M. FISHER,
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PETITION FOR WRIT OF CERTIORARI

TO THE HONORABLE, THE CHIEF JUSTICE AND ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioners, Forrest H. Smith, *et al.*, pray that a writ of certiorari issue to the United States Court of Appeals for the Fourth Circuit to review the judgment of that court in this cause filed June 2, 1950 (Appellees' App. 30). A petition for rehearing was denied on July 5, 1950 (Appellees' App. 55).

A certified transcript of the record in this case, including the proceedings in the Court of Appeals, is furnished herewith in compliance with Rule 38 of the Rules of this Court.

Summary Statement of the Matter Involved

This action arose as an action by petitioners in the United States District Court for the Eastern District of North Carolina, charging respondents with infringement of claims 1, 2 and 7 of petitioners' patent No. 2,051,348, dated August 18, 1936, relating to drying houses for curing tobacco.

On December 20, 1949, after a trial on the merits, judgment was entered (Appellants' App. 1) dismissing the complaint. No opinion was filed by the District Court, but Findings of Fact (Appellants' App. 2) and Conclusions of Law (Appellants' App. 9) were entered wherein the lower Court held, *inter alia,* that claims 1 and 2 were invalid because they failed to define invention over the prior art, and that claims 2 and 7 were limited by the inclusion of elements not contained in the defendants' structure and were therefore not infringed.

The Court of Appeals for the Fourth Circuit on appeal did not affirm the District Court's holding that claims 1 and 2 were invalid, and did not affirm the District Court's holding that claim 7 included limitations not present in defendants' structure. Instead, on its own initiative, and unsupported by the findings of the lower Court, the Court of Appeals held that the patent in suit was limited to the precise arrangement of heating units shown and described in the drawings and specification, and that when so construed, was not infringed.

The ruling of the Court of Appeals for the Fourth Circuit is clearly contrary to the ruling of this Court in *Graver Tank & Mfg. Co., Inc.* v. *Linde Air Products Co.,* 339 U. S. 605. The ruling is particularly without merit in the present case because the evidence is conclusive that the patentee was the first to produce a *successful* apparatus for curing tobacco by the open-flame method, and that the disclosure of his patent was in fact copied by the defendant with those minor variations in detail which this Court in the above mentioned decision commented on as rarely absent in the infringer's structure.

> *Graver Tank & Mfg. Co., Inc., et al.* v. *Linde Air Products Co.,* 339 U. S. 605, 607:
>
> "But courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the pro-

tection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law. One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system."

The patent in suit (Appellants' App. 120) discloses an apparatus for curing tobacco wherein the products of combustion from a large number of small independent oil burners are mixed with air drawn into the barn through appropriate openings and are so arranged that the mixture of gases through the natural laws of convection, passes upwardly through the overhanging tobacco to the discharge outlets in the roof. At the time plaintiff introduced his invention to the public by advertisements, public demonstrations, etc., the universal method of curing tobacco then employed was the "flue system" wherein heat is radiated from the hot metal surfaces of flues heated by furnaces, the products of combustion being confined in the flues and discharged to an outside chimney.

The patent in suit shows two alternate arrangements of heaters. In the preferred arrangement each burner has its separate hood, while in the alternate arrangement a common hood is provided for several aligned burners. Somewhat more than a year after the patentee introduced

his patented apparatus in the preferred form to the public, the defendant Mayo, who resides in the same section of North Carolina, brought out *his* apparatus employing the alternate arrangement described in the Smith patent, namely, the arrangement of a number of burners in line under a common hood.

Mayo introduced one innovation in his installation not found in the Smith patent. Instead of introducing the air for admixture with the flue gases through holes in the barn walls adjacent the location of the burners, he employed pipes leading from the holes in the barn walls to the hoods of the burners whereby the air was mixed with the products of combustion under the hoods instead of in the space surrounding the hoods. Mayo secured a patent of later date on this addition to the Smith patent.

A former employee of the Mayo Company, one Hardy, went in business for himself putting out an imitation of the Mayo apparatus, air pipe and all, and was sued by Mayo. The Court of Appeals for the Fourth Circuit found the Mayo patent valid on the ground that Mayo was the first to solve the problem of open-flame curing of tobacco; that in so doing he had satisfied a long-felt want, and that his patent was entitled to a liberal construction.

> *Florence-Mayo Nuway Co.* v. *Hardy, et al.*, 168 F. 2d 778, 780 (C. C. A. 4):
>
> "In the 1930s, as wood became scarce in the tobacco growing section of the Carolinas and Virginia, attempts were made to heat tobacco barns by the use of oil as a fuel; and the Mayo patent was directed to the use of oil for this purpose in the conventional type of tobacco barns. It unquestionably solved the problems presented in a way so satisfactory that it entered into immediate use and the manufacture of the heating devices of the patent enjoyed wide commercial success. Fifteen thousand of these devices

were sold within the course of a few years for around a million and a half dollars.

* * * * *

Practical raisers and curers of tobacco began using it to such an extent that the old devices ceased to be sold. Even if this be explained in part by changes in fuel supply and trade conditions, the fact remains that Mayo had furnished a practical solution to the problems which these changes presented."

In the Mayo case evidence of Smith's *prior* solution of that problem and his successful commercial exploitation of open-flame curing systems was not submitted. Indeed, it was asserted that no one prior to Mayo had succeeded.

In the case at bar the real facts were brought into evidence. It was proven, and not denied by Mayo, that the admission of air to the hood which the Court of Appeals for the Fourth Circuit was led to believe constituted the solution of the problem, had no effect on the operation, and that the prior Smith installations where the air was admitted adjacent the location of the burners but not under the burners, effected precisely the same curing of the tobacco. The Court of Appeals for the Fourth Circuit took occasion in their opinion in the case at bar to comment on this deception that had been practiced in the Mayo-Hardy case.

Smith, et al. v. *Florence-Mayo Nuway Co., et al.*, 182 F. 2d 507, 510:

"Since the Florence-Mayo Nuway Co. is a party to this suit, we think it not inappropriate to say that, in the light of the record here, the Mayo patent is not entitled to the liberal treatment of a pioneer patent, as indicated by our opinion in 168 F. 2d 778, but *like the Smith patent here should be treated as a mere improvement patent in a crowded field with a very narrow range of equivalents.* The majority of

> the court does not question the correctness of the decision holding the patent valid and infringed against the device of Hardy, which was a mere Chinese copy; but the evidence in the record before us shows clearly that the Mayo patent was not a pioneer patent and was not the first to achieve commercial success in the heating of tobacco barns with open flame oil burners, as we were then led to believe. Its monopoly is limited, therefore, *just as is the monopoly of the Smith patent, to the exact combination which it discloses.* Smith and Mayo seem to be in consimili casu in the light of the record in this case; and we feel that this should be made clear, so that no advantage may be taken of the fact that the court was misled by the undisputed evidence in the record in the former case into believing that Mayo was the first to solve the problem presented and the first to achieve commercial success. The evidence in the present case shows that up to the trial 14,350 of the Smith devices had been sold for $2,252,500." (Italics ours.)

The statements emphasized in the above quoted matter can only be characterized as incomprehensible. In the Mayo-Hardy case, where there was no evidence of Smith's prior operations, Mayo was found to be "a pioneer" in the field. That same field is in this opinion, on the same record of paper patents, characterized as "a crowded field" prior to Smith. The uncontradicted evidence of all the witnesses, including representatives of the Department of Agriculture of North Carolina and Virginia, is that when the Smith apparatus was introduced there were no other open-flame systems in existence.

Certain prior patents before the Court in both cases, namely, Mims (Appellants' App. 181), Brock (Appellants' App. 175) and Reynolds (Appellants' App. 191) disclose the *idea* of using open-flame oil burners in tobacco barns for curing tobacco. In all these prior

patents the heat is supplied by high pressure burners in the middle of the barn, so Smith limited his claims to burners located adjacent the walls of the barn. The claims so limited were allowed. In the patent drawings (Appellants' App. 120) fifteen individual burners are shown arranged in five groups of three each, one group in the center of the barn and the other four groups closely adjacent the walls of the barn—so close, in fact, that were the patent drawings regarded as dimensional drawings, a serious fire hazard would be incurred. In the Smith commercial installation, twenty burners are used (in a 16½ x 16½ barn) instead of the fifteen disclosed in the patent, the burners being arranged in four evenly spaced rows (Appellants' App. 34) with the hoods of the burners in the outer rows and the end burners in each row about one foot from the barn walls (Appellants' App. 73).

Mayo uses twenty-four burners in a 16 x 16 barn, usually in four groups of six burners each. A single hood in each instance is supplied to each group of burners.

The burners in each group of the Mayo structure are arranged in a row attached to a common feed pipe and the rows of burners instead of being so arranged that the *sides* of the hoods are parallel, respectively, with the four walls of the barn have the *ends* of the hoods spaced one foot from the side walls of the barn, the space under each hood being connected to the air intake openings in the wall of the barn by means of short pipe sections (see Appellants' Exhs. M, N, O and S, pp. 134-142 Appellants' App.).

The uncontradicted evidence is that in the sense of the patent the burners in the commercial installations of the parties are "adjacent" the walls of the barn in that they are near enough for the natural convection currents to produce a uniform distribution of the heated gases around the walls of the barn, as distinguished from the proposed structures of the prior art wherein the combustion gases are generated solely in the middle of the

barn. The patent structure and the commercial installations of both parties embody a large number of small burners, some of which are near the walls of the barn and some of which are near the middle of the barn. The prior patents disclose either a single burner, or a single group of three burners at the middle of the barn and no burners adjacent the walls of the barn. The limitation to burners "adjacent the walls of the barn" excludes the prior art disclosures but does not limit the claims to a particular number of burners at a particular distance from the walls, but includes all arrangements wherein a sufficient number of burners are close enough to the barn walls to accomplish the desired result which is not obtained by the prior arrangements.

The Court of Appeals attempts to support its holding that the patent in suit is limited to the "exact combination which it discloses" by reference to the proceedings in the reissue application and the co-pending application wherein the patentee was denied broader claims—*not limited to burners adjacent the barn walls.* As the patent in suit with the claims here in issue was granted prior to the proceedings referred to, such proceedings can manifestly in nowise affect the construction to be given these previously granted claims. Obviously also the validity or invalidity of claims *not* containing the limitation in question has no bearing on the construction to be placed on that limitation. As pointed out in the appended brief, all the cases cited by the Court of Appeals in support of its reference to the reissue application relate to the ordinary case of "file wrapper estoppel."

Jurisdiction

The jurisdiction of this Court is invoked under Sec. 240(a) of the Judicial Code as amended by the act of June 25, 1948, c. 646 (28 U. S. Code, Sec. 1254).

The judgment of the Court of Appeals for the Fourth Circuit which petitioners seek to have reviewed was entered on June 2, 1950 (Appellees' App. 30) and petition for rehearing denied on July 5, 1950 (Appellees' App. 55).

The Questions Presented

1. Whether or not patent claims are to be construed as limited to the exact construction shown and described so as to exclude from the scope of the patent apparatus which accomplishes the same result by the same or equivalent means.

2. Whether or not a patent on a commercially successful apparatus which solved a problem of long standing is to be given a liberal construction so as to include within its scope the device of an imitator who appropriates the substance of the invention and makes "unimportant and insubstantial changes and substitutions" (*Graver* v. *Linde, supra*) where such changes are not definitely excluded by the claim language.

Reasons for Granting the Writ

The "doctrine of equivalents" reasserted by this Court in *Graver* v. *Linde, supra,* is of the utmost importance in the proper administration of patents. There are, and should be, no exceptions to the rule. There are no circumstances under which a patentee may have a valid patent and yet be denied all range of equivalents. If the prior art discloses apparatus which accomplishes the same result by the same or equivalent means there is no ground for a valid grant. On the other hand, if the patentee's structure constitutes a significant contribution to the arts and claims are granted with limitations which exclude the prior disclosures, such limitations should not be so narrowly construed as to exclude also the imitator's structure which embodies the substance of the patentee's structure and secures the same result by equivalent means.

WHEREFORE YOUR PETITIONERS respectfully pray that a writ of certiorari be issued to the United States Court of Appeals for the Fourth Circuit to the end that this cause may be reviewed and determined by this Court; that the judgment of the Court of Appeals for the Fourth Circuit be reversed; and that petitioners be granted such other and further relief as may be proper.

CLARENCE M. FISHER,
W. BROWN MORTON,
Counsel for Petitioners.

New York, September 29, 1950.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinion of the Courts Below

No opinion was handed down by the District Court. Its Findings of Fact and Conclusions of Law appear on pages 2 to 10 of the Appellants' Appendix. The opinion of the Court of Appeals for the Fourth Circuit, Circuit Judges Parker, Soper and Dobie (written by Judge Parker) appears at page 24 of the Appellees' Appendix and is reported in 182 F. 2d 507.

Jurisdiction

The jurisdictional statement appears in the accompanying petition.

Statement of the Case

The essential facts of the case are stated in the accompanying petition and need not be related here.

Specification of Errors

The Court of Appeals for the Fourth Circuit erred:

1. In holding that "the monopoly of the Smith patent," (here in suit) is limited "to the exact combination which it discloses".

2. In holding that the Smith patent in suit is not infringed by the Mayo installations.

3. In holding that the construction of the claims of the original Smith patent here in suit is affected by the refusal of broader claims in the application for the reissue of that patent and in the later filed companion application.

ARGUMENT

1

As pointed out in the foregoing petition the ruling of the Court of Appeals of the Fourth Circuit that the Smith patent is limited to the exact combination which it discloses is contrary to the ruling of this Court in *Graver* v. *Linde,* 339 U. S. 605. The Smith patent in suit discloses the first successful installation for curing tobacco by the open flame method. The claims are therefore entitled to a liberal construction. (*Morley Sewing Machine Co.* v. *Lancaster,* 129 U. S. 263, 273).

None of the conditions is present in the case at bar which justifies a strict interpretation of the patent claims. The prior patents presented in support of the defense of invalidity are in substance the same as those fully considered by the Patent Office in granting the patent.

The language selected to differentiate the patented structure from the prior art structure was not intended to express a difference in degree, but a difference in kind. In the prior art structures, the one, two or three burners are located in the middle of the barn. The Smith patent discloses three burners in the middle of the barn, but it also discloses twelve additional burners located adjacent the walls of the barn. The limitation of the claims to burners adjacent the walls of the barn was intended to identify these burners and include them in the claims, and thereby distinguish the claims from the prior art wherein such burners were absent. To read the term "adjacent" as limited to the particular arrangement of burners with relation to the barn walls disclosed in the patent would not be justified even were the Smith apparatus merely an improvement on apparatus already successfully used for curing tobacco by the open flame method.

The ruling of the Court of Appeals that the limitation to burners adjacent the walls excludes the defendants' structure finds no support in the Findings of the lower Court.

The lower Court held that claim 2 was not infringed because limited to the "screens" and that claim 7 was not infringed because limited to "baffle means comprising perforate and imperforate portions". It is to be assumed that if the lower Court found also that the claims were not infringed because limited "to burners adjacent to the walls", a finding to that effect would have been included. In view of the fact that there was no adverse finding on the question of whether or not the burners were adjacent the walls of the barn in the infringing structure the ruling of the lower Court on this point was considered as favorable to appellants.

Even if the patentee be put "at the mercy of verbalism" (*Graver Tank & Mfg. Co.* v. *Linde Air Products Co., supra*) in construing his claims, claim 1 cannot be construed as limited to the exact arrangement shown in the patent drawings. Claims 2 and 7 describe the burners as "a plurality of spaced independent fuel-burning heating units located within the house and arranged in series *extending substantially around and* adjacent the walls thereof" (Italics added). The italicized words are omitted from claim 1 and under the well established doctrine that a limitation present in one claim and omitted from another may not be added to the other claim by construction, claim 1 must be given a broader interpretation than claims 2 and 7. In other words, if the italicized words are read as limiting claims 2 and 7 to the precise arrangement of aligned burners parallel with the barn walls as illustrated in the patent drawings, claim 1 cannot be construed as limited to that parallel arrangement.

2

The claims are infringed by the Mayo installations. The Smith commercial installation for a small barn consists of twenty individual oil-burning heaters, each with its individual hood, arranged in four rows of five burners each, the hoods of the fourteen outside burners being spaced about one foot from the barn walls. This is substantially the arrangement disclosed in Fig. 1 of the patent drawings which shows the preferred arrangement except that a few more burners are employed in practice and in the patent there is but one row of burners across the middle of the barn instead of two. Also in the patent drawings, if they be regarded as dimensional drawings, the distance between the burners and the walls of the barn is less than one foot. Patent drawings, however, are not dimensional drawings and quite obviously if the burners were closer to the barn walls than one foot a serious fire hazard would be involved in case the burners flared up, as they sometimes do (Appellants' App. 66).

In the Mayo commercial installations the burners are arranged in groups of four or six under a common hood for each group, as decribed in the patent in suit as an alternate arrangement (p. 3, col. 1, ll. 21, *et seq.* of the patent specification, Appellants' App. 120). The groups of aligned burners in the Mayo commercial installations are arranged with their ends adjacent the barn walls at the same one-foot distance from the walls. The witness Blackburn, who compared a Smith commercial installation with a Mayo commercial installation at the farm of the witness Gray, found that the heat distribution from the two installations was essentially the same and that in both cases a "blanket of heat" (Appellants' App. 73-79) was maintained against the side walls of the barn and that a uniform temperature was thus maintained throughout the barn space. There was no evidence to the contrary. In fact, the defendant, Mayo Co., claims as one

of the advantages of its open flame installation that it does in fact maintain a uniform temperature throughout the barn. It is thus conclusively established that the defendant's apparatus accomplishes the same result as the patented apparatus by the same or equivalent means.

The Court of Appeals for the Fourth Circuit in holding that the word "adjacent" in the patent claims excluded the Mayo construction disregarded the ordinary literal meaning of the word itself. The claims cannot be construed *in vacuo* without regard to the nature of the apparatus to which they are directed. "Adjacent" does not mean any particular distance in feet or inches, but such nearness as is necessary to accomplish the intended purpose. A person is adjacent the fire if he is near enough to be warmed by the fire. On the other hand, a tea kettle is adjacent the fire only if it is near enough for the water in the tea kettle to be heated to the desired temperature for making tea. "Adjacent" in one case would mean a much smaller distance than in the other. In the curing of tobacco, as explained by the witness, the burners must be near enough to the barn walls to blanket the walls with hot gases. The uncontradicted testimony is that the Mayo installation and the Smith installation functioned alike in this regard.

There is nothing in the prior art which justifies a more limited construction than the term "adjacent". The open flame curers of the prior art are disclosed in the three paper patents to Mims, Reynolds and Brock. In all these installations the burners—one, or three in number—are high intensity burners located in the middle of the barn. They were cited by the Examiner in the prosecution of the application for the patent here in suit and the claims including the expression "adjacent the walls of the barn" were allowed. So construing the claims in the light of the Patent Office proceedings, as they should be, they mean an arrangement of burners near the walls of the barn, as distinguished from an arrange-

ment of burners in the center of the barn. In the Mayo construction all the heated gases developed by half the burners are discharged into areas nearer the walls of the barn than the middle of the barn, and half the combustion gases from the remaining burners are likewise discharged in areas nearer the walls of the barn than the center of the barn. The distribution of the hot gases between the center and walls is almost precisely the same as in the patent in suit, where all the gases from one-fifth of the burners are discharged in the center of the barn and all the gases from the balance of the burners are discharged around the walls of the barn.

3

The refusal of broader claims in the reissue application and companion application has no bearing on the previously granted claims of the patent in suit.

The claims here in suit were already granted at the time of the reissue application and the companion application. The reissue was not sought to alter these claims but to obtain additional claims. When the patentee abandoned his reissue application he merely took back what he already had. He could have taken back these claims even though the Patent Office in the reissue application had held that they were anticipated—which, however, the Patent Office did not.

By the reissue and companion applications the applicant sought (1) an additional claim defining the arrangement of the burners, not in terms of the walls of the barn, but in terms of the heat distribution; and (2) a claim to the nature of the burners themselves, namely, doll size burners in a room of ordinary size. The patentee failed to get this additional protection, but that fact is pertinent to the proceedings here only under the Biblical doctrine that "to him that hath shall be given, and from him that hath not even that which he hath shall be taken away".

The authorities cited by the Court of Appeals in support of its findings that the reissue proceedings are pertinent to the interpretation of the claims, do not support the Court's position. In *Altoona Theatres* v. *Tri-Ergon,* 294 U. S. 477, the claims in issue were not the original claims of the patent but were claims limited by disclaimer and the Court held that the rule of file wrapper estoppel applied to the same extent as though the claims had been limited or abandoned in the original application. There was no reissue application in *Keystone Driller Co.* v. *Northwest Engineering Corp.,* 294 U. S. 42. That case merely states the ordinary well established rule of file wrapper estoppel. The same is true of *Smith* v. *Magic City Kennel Club,* 282 U. S. 784.

Conclusion

The ruling of the Court of Appeals for the Fourth Circuit that the Smith patent in suit is in the same category as it now places the Mayo patent is incomprehensible. In the Mayo-Hardy case the Court of Appeals accorded the successful curing of tobacco by the open flame method the status of a pioneer invention. There is nothing in the record of the case at bar to alter that decision. Substantially the same prior art was cited in both cases. The record here shows that Smith, and not Mayo, is the pioneer inventor.

WHEREFORE, petitioners earnestly pray that this petition for writ of certiorari be granted, the cause reviewed, and the decree of the Court of Appeals for the Fourth Circuit reversed.

Respectfully submitted,

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W. BROWN MORTON,
Counsel for Petitioners.

Dated: New York, N. Y., September 29, 1950.

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v.

FLORENCE-MAYO NUWAY COMPANY ET AL., *Respondents.*

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

There are no grounds stated in the Petition herein, or in the Petitioners' brief, that establish any basis for bringing this case within the provisions of the rules of this Court.

This is an ordinary patent case, involving only the issue of infringement, which has been decided by the District Court below, and which has been reviewed and unanimously affirmed by the Court of Appeals for the Fourth Circuit (182 F. (2d), 507; Petitioners' App., 24).

The patent in suit has not been litigated in any other circuit, so that there are no conflicting decisions of any courts of appeal.

The only ground advanced in support of the petition is the allegation that the ruling of the Court of Appeals for the Fourth Circuit "is contrary to the ruling of this Court in *Graver* v. *Linde*, 339 U. S., 605" (Petition p. 2 and Brief, p. 12). As will be shown, there is absolutely no basis for any such allegation.

What the petition in this case is *really* requesting is a reconsideration by this Court of the issue of infringement, which has been decided adversely to petitioners in both the District Court and Court of Appeals below, and which neither requires nor warrants any further consideration.

The present case is based on the *same* patent (No. 2,051,348, Smith) as was involved in the case of *Forrest H. Smith et al.* v. *General Foundry and Machine Co., et al.*, in which a Petition for Certiorari was brought before this Court at the October Term, 1949, (No. 325) by the *same* Petitioners. In that case, the issue of infringement had likewise been decided adversely to petitioners by both the District Court and the Court of Appeals for the Fourth Circuit, and the Petition for Certiorari was accordingly *denied*. It is urged that it should be similarly denied in the present case.

In amplification of Petitioner's reference, on page 2, to the decision of the Court of Appeals affirming the decision of the District Court, attention is directed to the following quotations from said decision:

> "We do not think it necessary to pass upon the validity of the claims in suit, for when they are limited, as they (fol. 11) must be, by the prior art, they are clearly not infringed by the devices of the defendants. This is perfectly clear as to claim 2, which calls for *a screen which defendants do not use;* and we think it equally clear as to the other claims. In claim 1, the requirement is that the *independent* fuel burning units be *'arranged in series adjacent the walls'* of the tobacco barn; and in claim 7, as in claim 2, there is a requirement that the *heating units* be *'arranged in series extending substantially around and adjacent the walls'* ". (Italics ours.)

In an earlier part of its decision the Court of Appeals, in applying the prior art, stated:

> "The record in this case clearly shows that there was nothing new in the use of open flame oil burners for heating tobacco barns. Brock Patent No. 1,368,018 discloses as heating means of tobacco barns, long perforated bunsen burner type heaters covered by an adjustable hood. Reynolds Patent No. 1,509,902 shows the use of an open flame burner under a hood. Other prior art patents of which notice should be taken are the Mims Patent No. 1,493,889, showing the use of an open flame oil burner covered by a hood for treating vegetables and Fizer Patent No. 265,051, showing a number of heaters, but without oil burners, arranged along the walls of a tobacco barn. Account must be taken also of the Torrid Stove installation, which consisted of independent oil burning stoves used for heating purposes in tobacco barns and of the teaching of Agricultural department bulletins as to the use of open flame burners in series for the production of gases for the coloring of oranges and grapefruit.
>
> In the light of this prior art it is idle to contend, as does appellee, that the claims in suit should be so broadly construed as to give the patentee a monopoly on the use of open flame burners in the curing of tobacco."

Errors and Inaccuracies in the Petition and Brief.

It is not seen wherein the decision of the Court of Appeals for the Fourth Circuit in the case of *Florence-Mayo Nuway Co.* v. *Hardy, et al.*, 168 F. 2d 778, (C. C. A. 4) is pertinent to the issue here under consideration. However, since the decision has been brought into the Petition and Brief, reply is here made particularly for the purpose of correcting errors and inaccuracies in said Petition and Brief.

On page 4 of the petition, it is stated that the "Court of Appeals for the Fourth Circuit found the Mayo patent valid on the ground that Mayo was the first to solve the problem of open flame curing of tobacco".

But the opinion (168 F. (2d) 778) says that

> "There is nothing in the prior art which anticipates the combination (claimed). What was new was the combination of these (old elements) *with a device for delivering the outside air under the hood and over the burners*, . . . such a combination was nowhere shown in the prior art". (Italics ours.)

Also:

> "Defendants' infringing device adopted the heart of the Mayo invention".

Moreover, the Court observed (Petition, p. 6) that the Mayo patent was held

> "valid and infringed against the device of Hardy, which was a mere Chinese copy"—

In other words, this was merely a case of a specifically new idea covered by a valid patent, and held infringed by an *identical* device. The court held it was not a pioneer patent.

Similarly, the Smith patent here in suit is not a pioneer patent, and must likewise be "limited to the exact combination which it discloses". It may be infringed by any one using this "exact combination", but the Court of Appeals held that the accused structure of respondents is decidedly different and "does not infringe the claims of the patent". (Petitioners' App. p. 29.)

Thus there is nothing inconsistent in the ruling of the Court of Appeals in the two cases.

On page 5 of the petition, reference is made to comments of the Court of Appeals on the "deception that had been practiced in the Mayo-Hardy case". This is a misstatement. The observation made by the Court was that it "was misled by the undisputed evidence in the record into believing that Mayo was . . . the first to achieve commercial success". (Petition, p. 6)

At the bottom of page 3 of the petition, reference is made to Smith's "alternate arrangement" in which a "common hood is provided for several aligned burners" (as distinguished from a separate hood for each burner), and the statement is made (top p. 4) that after Smith got started "The Defendant Mayo brought out *his* apparatus employing the alternate arrangement described in the Smith patent". This infers that Mayo copied Smith's "alternate arrangement", but the fact is Mayo began to manufacture his accused heating units in 1935, (Appellants' Appendix, p. 29) *before* the Smith patent issued (August 1936). Not only was Mayo selling his improved heating units before Smith's patent issued, but he was making and selling them *before Smith ever offered to the public his so-called alternate arrangement.* This alternate arrangement was first offered as "Model D", shown in Smith's descriptive circular "Appellants' Exhibit I" (Appellants' App. p. 129). The record is silent as to the date of this circular, but it bears on its face the number of the Smith patent, so it could not have been published until after August, 1936, the date of issuance of this patent.

At the bottom of page 6 of the Petition it is stated that the same prior patents, including Mims, were before the court in both the *Mayo-Hardy* case and the present case. This is an error. The important patent to Mims was *not* before the court in the *Mayo-Hardy* case. Nor were the various publications and prior uses, which influenced the Court of Appeals in the present case. (182 F. 2d, 507.)

At the top of page 7 of the petition, there is no basis in the record for "high-pressure burners", and such a designation is unwarranted.

On pages 12 and 15 of the brief it is asserted that the "prior patents presented in support of the defense of invalidity are the same as those fully considered by the Patent Office in granting the patent". This again is an error. The Patent Office did *not* consider the important patent to Mims. Neither did it have before it the Agriculture Dept.

Bulletins and prior use of the "Torrid" oil-burning heater on which the present defense was based.

On page 15 of the brief, reference is made to the "paper" patents of Mims, Reynolds and Brock. This too, is misleading. The Reynolds patent was *far* from being a mere "paper" one. The Reynolds curer had been quite widely used in actual practice and had operated successfully. Note particularly the deposition of Moss, beginning at p. 108 (Appellants' Appendix). This witness said that he had made "two or three curings" with the Reynolds equipment (p. 110); that there were "some used in the eastern part of the state" (p. 111); that the Reynolds "would yellow the tobacco alright"; and if he had had "additional capacity of the same kind" it would have cured the tobacco "through to completion" (p. 115, 116).

Note also the deposition of S. B. Mercer (pp. 105-106). This witness says that, although somewhat expensive, he "*did* cure three barns with the Reynolds".

Finally, in the "Conclusion" on page 17 of the brief it is again asserted that "the same prior art was cited in both" the Mayo-Hardy and the present case. It must be *again* pointed out that neither the Mims patent nor the publications and prior uses discussed by the Court of Appeals here were in evidence in the Mayo-Hardy case.

Reply to Petitioners' Argument.

In many places throughout the petition and brief reference is made to the exact character of the "Smith commercial installations".

It is submitted that the character of these installations is *wholly immaterial*. The *sole* question here presented is that of the interpretation and alleged infringement of the *claims* of the patent, and a consideration of Smith's commercial installations cannot possibly throw any light on this question.

> "The claim is a statutory requirement, prescribed for the very purpose of making the patentee define pre-

cisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms." (*White* v. *Dunbar*, 119 U. S., 47).

"The claims measure the invention. They may be explained and illustrated by the description, but they cannot be enlarged by it". (*Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U. S., 405).

I.

The brief (pp. 14, 15) stresses that the Smith and Mayo actual installations function in a similar manner, and produce the same result or accomplish the same general purpose, and argues that therefore they must be patentably the same. But this argument is not supported by the law.

> "Any one may lawfully accomplish the same end without infringing the patent, if he uses means substantially different from those described". (*O'Reilly et al.* v. *Samuel Morse et al.*, 56 U. S., 62-[119])
>
> "The argument used to show infringement assumes that every combination of devices in a machine which is used to produce the *same effect* is necessarily an equivalent for any other combination used for the same *purpose*. This is a *flagrant* abuse of the term 'equivalent' ". (*Boyden Power Brake Co.* v. *Westinghouse*, 170 U. S., 537.) (Italics ours.)
>
> "But, after all, even if the patent for a machine be a pioneer, the alleged infringer must have done something more than reach the same result. He must have reached it by substantially the same or similar means" (Id.).
>
> "That two machines produce the *same effect will not justify* the assertion that they are substantially the same, or that the devices used by one are therefore mere equivalents for those of the other". (*Burr* v. *Duryee*, 68 U. S., 531 [572]) (Italics ours.)

Incidentally, it may be pointed out that there is no reference whatever in the Smith patent to any alleged "blanket of heat" (p. 14) or to "blanket the walls with hot gases" (p. 15). This idea originated in the active imagination of plaintiff's expert.

II.

It cannot be seen that the ruling of the Court of Appeals is in any way inconsistent with or contrary to the decision of this Court on which Petitioners rely, namely *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.* (339 U. S., 605). This decision merely re-affirms the well known doctrine of equivalents which, as stated in the opinion itself, has been recognized for "almost a century". As the Court says, it is "available for utilization when the proper circumstances for its application arise". Also:

> "What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case".

Furthermore, the Court in this case was careful to point out:

> "The wholesome realism of this doctrine is not always applied in favor of a patentee but is sometimes used against him. Thus, where a device is so far changed in principle from a patented article that it performs the same or a similar function in a substantially different way, but nevertheless falls within the literal words of the claim, the doctrine of equivalents may be used to restrict the claim and defeat the patentee's action for infringement. Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 568."

Consequently, in view of the construction and manner of operation of the Mayo device paralleled with the essential limitations of the claims of the Smith patent, as stressed in the Court of Appeals' decision, if the *Graver Tank* case is applicable, it would have to be used against the patentee, instead of for him.

III.

It is submitted, the doctrine of equivalents is *not applicable* to the case at bar. The question of infringement of the Smith claims does not depend for its answer on the doc-

trine of equivalents, but rather on the elementary principles of interpretation of the claims in the light of the file history.

(a) "Adjacent."

As to the limitation "adjacent the walls of the barn" which Petitioners so particularly stress, attention is called to the language used in claim 1. This claim calls for a drying house having "side walls and end walls" and a plurality of burners "arranged in series adjacent the walls (*all four walls*) thereof". This is clearly shown in Fig. 1 of the Smith patent drawing.

A typical installation of respondents is shown in the Florence-Mayo descriptive circular "Appellants' Exhibit N" (Appellants' App. p. 137). This installation comprises four units arranged one near each corner of the barn. In the first place, *two* things only cannot be said to constitute a "series", so the only "series" present in respondents' installation is the series of burners contained in each unit. But these series of burners are disposed parallel with *two* walls of the barn only, namely the two opposite side walls, and not all four walls as shown and claimed by Smith. In the second place, these two series of burners are located 3½ feet from the walls with which they are parallel, and seven feet apart, i.e., 3½ feet from the center of the barn. Thus the series of burners are the *same distance* from the walls as they are from the center of the barn, and are no more "adjacent the walls" than they are adjacent the center of the barn.

In sharp contrast to this, the Smith patent (p. 2, line 30), refers to his units as "wall burners", and shows them in Fig. 1 as *closely* adjacent all four walls. The two ideas are wholly and fundamentally different.

(b) "Independent."

Claim 1 requires the burners constituting the series to be "independent".

The word "independent" does not occur in the Smith specification, and it is necessary to examine the file history to gain any light on what it is intended to mean.

This file history (Defendants' Exhibit 17) shows that claims 1 and 2 were first rejected as "not patentably distinguishing" from the claims of the first Smith patent No. 1,811,980 (Appellants' App., p. 207), now expired. Smith's solicitor then inserted by amendment the word "independent" (p. 42 of file), and argued (p. 43) that the claims of the prior patent include " 'a substantially horizontal flue extending adjacent to and inside the walls', and not a plurality of spaced, independent units, as called for" by the present claims.

On this argument, claims 1 and 2 were then allowed.

It will be apparent by reference to Fig. 1 of the first Smith patent (Appellants' App., p. 201) that it discloses every single element of claim 1 here in suit, if the word "independent" be omitted. It clearly contains a "plurality of spaced, fuel burning heating units located within the house and arranged in series adjacent the walls thereof" *exactly the same* as the Smith patent here in suit. Furthermore, the products of combustion in this first patent are discharged into the barn through the adjustable dampers 13 above the burners, just as they are discharged in the patent in suit. But the products of combustion from these "spaced heating units" in the prior patent *first enter a common conduit,* namely the flue 8, and are then discharged. Claims 1 and 2 of the patent here in suit were allowed, over the prior Smith patent, on the theory that they distinguished therefrom by calling for heating units which are "independent" of each other, that is to say, each unit is an *individual, separate* device, with its own hood, or baffle, as shown in Figs. 1 and 2 of the Smith patent in suit (Appellants' App., p. 120).

With such an arrangement of burners, each functions separately to generate its own rising column of combustion gases. It is therefore clear that claim 1, limited as it is

to "independent" burners, specifically defines the arrangement of Figs. 1 and 2 of Smith, the so-called "preferred form". There is *nothing* in the Smith patent or file history to indicate that claim 1 applies, or was ever intended to apply to the so-called "alternate arrangement", namely that shown in Figs. 12 to 14, and described in lines 22 to 32, column 1, p. 3 of the Smith specification. Obviously claim 1 does *not* apply to this "alternate arrangement", because in it a plurality of burners or heating units are disposed under a common hood or conduit, just as in the first Smith patent (now expired), and hence are *not* "independent", within the meaning of the claim.

> "Where the actual invention, described in the specification, is larger than the claims of the patent, patentee, in suit for infringement, is limited to what is specified in the claims". (*Bates* v. *Coe*, 98 U. S. 38).
>
> "When his application was rejected by the Patent Office, . . . the applicant, without objection or appeal, amended his claim" . . .
>
> "Having thus narrowed his claim . . . in order to obtain a patent, the patentee may not by construction, or by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments". (*Weber Elec. Co.* v. *Freeman Elec. Co.*, 256 U. S., 668)
>
> "The patentee, having . . . made it an element of these two claims, is not now at liberty to say that it is immaterial, or that a device which dispenses with it is an infringement, though it accomplish the same purpose, in, perhaps, an equally effective manner".
>
> "The novelty of the invention is at least open to doubt, and we think the patentee should be held to a rigid construction of these claims". (*Wright* v. *Yuengling*, 155 U. S., 47.)

Respondents' structure is not like Fig. 1 of Smith. In Respondents' structure there are a plurality of spaced "heating units" disposed *under a common hood*, like the "alternate arrangement" shown in Figs. 12 to 14 of Smith. The products of combustion from all of these burners first

enter this common hood or horizontal conduit, which serves as a mixing chamber, and the mixed gases are then discharged, the *same as in the expired Smith patent.* In this patent the products of combustion first enter and are mingled in a common flue or horizontal conduit, and are then discharged. Thus the units in Respondents' structure are not "independent", within the meaning which must be given to this word, particularly in view of the file history of the Smith patent in suit. Respondents do not employ the one feature which was asserted to render the claims of the patent in suit patentable over the prior Smith patent, and hence they do not infringe.

(c) Claims 2 and 7.

Claims 2 and 7 are more specific than claim 1. They require the series of burners to extend "substantially around and adjacent the walls". This obviously means *all four* walls, and as pointed out above, Respondents' burners are not so arranged.

Moreover, claim 2 definitely recites an element which, admittedly, Respondents do not employ, namely, "a screen". For these two reasons the Court of Appeals held this claim not infringed.

The same is true of claim 7, as to the first reason, and, moreover, claim 7, in its last few lines, recites a structure not used at all by Respondents.

> "In such a (combination) claim, if the patentee, specifies any element as entering into the combination, . . . he makes such element material to the combination, and the court cannot declare it to be immaterial" (*Fay* v. *Cordesman*, 109 U. S., 408).

CONCLUSION.

1. The decision of the Court of Appeals is in no way inconsistent with or contrary to the ruling of this Court in *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, or any other case;

2. The doctrine of equivalents is not applicable to the case at bar;

3. The prior art cited in the present case was much more comprehensive than that cited in the Mayo-Hardy case, and influenced the Court of Appeals to hold that neither Smith nor Mayo were pioneers, but that the patents of both were mere improvement patents and must be limited to the exact combinations disclosed;

4. Claim 1 of Smith is limited by the plain import of its language and definitely by its file history to an arrangement which is wholly different from that used by Respondents;

5. Claims 2 and 7 specifically include, in their combination, elements which Respondents do not employ;

6. Therefore, the ruling of the Court of Appeals that these claims are not infringed is fully warranted, and should not be disturbed.

It is respectfully submitted that the petition fails to advance any proper ground for granting a writ of certiorari in this case, and particularly fails to show any conflict of opinion among the several Courts of Appeal, or any error herein by the Court of Appeals for the Fourth Circuit, and it is urged that the petition should be denied.

Respectfully,

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Bernard F. Garvey,
Counsel for Respondents.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1950

No. 341

FORREST H. SMITH ET AL., *Petitioners*

v.

FLORENCE-MAYO NUWAY COMPANY ET AL., *Respondents*

PETITIONERS' REPLY BRIEF.

CLARENCE M. FISHER,
W. BROWN MORTON,
Counsel for Petitioner.

New York, N. Y.,
November 15, 1950

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

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PETITIONERS' REPLY BRIEF.

Respondent's brief follows the usual pattern of discussing issues which are not relied upon as reasons for granting the writ and ignoring those issues which are relied upon in an attempt to make it appear that the case presents no questions which would justify this Court in reviewing the decision of the Court of Appeals of the Fourth Circuit.

It is not contended by petitioners that the Courts in two different Circuits have rendered conflicting decisions with regard to the scope or validity of the patent here in suit, but that is no reason for denying this petition. In many, probably most of the patent cases which this Court in recent years has reviewed on certiorari there have been

no conflicting decisions with respect to the scope and validity of the particular patent in suit. In most of these cases the reason for granting the writ has been that in the decision reviewed, the lower Court has misconstrued or misapplied some rule of law of sufficient importance to justify an authoritative settlement of the question by a review by this Court.

This Court is also not entirely unmindful of the injustice to the litigant resulting from the failure of the lower Courts to follow the authoritative rulings of this Court, particularly where, as here, the lower Court has completely reversed its own previous decision on the same facts.

On page 3 of its brief respondent alleges that the decision of the Circuit Court of Appeals in the Mayo-Hardy case is not pertinent to the issue here under consideration. It is particularly pertinent here because the decision in this case is in direct conflct with the decision in that case. In the Mayo-Hardy case the Court found the successful curing of tobacco by the open flame system to be a notable achievement, and, being misled by the appellees here into believing that that success was due to the delivery of the conditioning air to the hoods of the burners to which the Mayo patent claims are directed, gave to the Mayo patent (by that Court's own statement in the opinion in this case) "the liberal treatment of a pioneer patent."

> "Since the Florence-Mayo Nuway Co. is a party to this suit, we think it not inappropriate to say that, in the light of the record here, the Mayo patent is not entitled to the liberal treatment of a pioneer patent, as indicated by our opinion in 168 F. 2d 778 . . ." (Appellees' App. 29)

The record here which disclosed to the Court of Appeals of the Fourth Circuit that they had been deceived by the evidence presented in the Mayo-Hardy case, establishes that Smith, and not Mayo, solved the problem of curing tobacco by the open flame system—that the problem was solved by what Mayo took from Smith and not by the air

pipe to the hood, as they had been led to believe. The status of pioneer which the Court of Appeals for the Fourth Circuit erroneously conferred upon Mayo should rightfully have been conferred upon Smith.

Respondents in their brief, on page 6, refer to the testimony of Moss and Mercer in support of its assertion that the Reynolds curer "had been quite widely used in actual practice and had operated successfully." This statement is directly contrary to the statements of the witnesses themselves. Moss was specifically asked whether or not the Reynolds device operated satisfactorily, and he said it did not.

> "Q. 20. What would you say, Mr. Moss, with reference to whether or not the Reynolds curing system of the type installed on the premises of the Experiment Station and to which you have referred was or was not a commercial success?
>
> A. 20. It was not satisfactory and therefore we never did use the second one. It was not a commercial success locally.
>
> Q. 21. Do you know of any other person who undertook to use or operate one?
>
> A. 21. I do not know positively. There was some of them used in the eastern part of the state—I do not know where.
>
> Q. 22. You do not know, do you, Mr. Moss, with what degree of success if any the people to whom you refer as being down east were able to operate the system?
>
> A. 22. Let's get that clear.
>
> Q. 23. You do not know with what degree of success, if any, the people you refer to as being down east experienced in their efforts to operate the system?
>
> A. 23. No sir." (Moss, Appellants App. 110-111)

Mercer stated that the quality of the tobacco was so impaired that he discarded the apparatus.

> Q. State whether or not, in your opinion, Mr. Mercer, the commercial value of the tobacco you undertook to cure in the barn with the Reynolds curer was less than if you had cured it in a barn equipped with the ordi-

nary flue and furnace system? A. I should say it was 25% damaged.

Q. You mean that it was worth 25% less? A. That is right, yes sir.

Q. Mr. Mercer, to your knowledge has anyone been able to successfully cure tobacco with the Reynolds curer such as you have described? A. Not as I ever heard tell of. Never have seen any more of them after that year. (Mercer, Appellants' App. 107)

Respondents' discussion on pages 9-12 of their brief, under the headings "Adjacent" and "Independent" demonstrate the extent to which the Court of Appeals of the Fourth Circuit read into the claims the details of the structure disclosed in the patent in suit in order to exclude from their scope the accused apparatus. Thus, respondents contend that "adjacent the walls" means all four walls of the barn, although the number of walls is not recited in the claims; also, that *all* of the burners of the series must be closely adjacent the barn wall, as shown in the patent drawing where the series of burners are *parallel* with the barn walls, although nothing is said in the claims as to whether the series of burners is parallel with or perpendicular to the barn walls.

Respondents contend that referring to the burners as "independent" limits the claims to the preferred embodiment with each burner under a separate hood, and excludes the alternate arrangement described in the patent in suit where a common hood is provided over several associated burners. This interpretation is obviously contrary to the language of the claims themselves. Claim 7 is specific to the alternate form of apparatus with the "associated burners" under a single baffle and also includes the burners as "independent fuel burning heating units." Quite obviously the definition of the heating units as "independent" was not intended to limit the claims to the preferred form of apparatus with a separate hood for each burner, but was intended merely to exclude the structure disclosed in the

patentee's earlier patent (Appellees' Appendix, 201) wherein *all* the burners are installed in a common flue.

The balance of respondents' brief is taken up with matters quite irrelevant to any issue presented here, such, for example, as the reference on page 2 to the prior suit by petitioners against the General Foundry & Machine Company.

This reference can have no other purpose here than to mislead this Court into believing that the questions presented by this petition are the same as those presented by the petition in the former case. Respondents fail to mention that the patent here in suit contains, in addition to the claims here in issue on the open flame curing system, a claim—claim 3—not here in suit, directed to an adaptation of the oil burners for heating the flues of the old-fashioned wood-burning flue system. That was the sole claim in issue in the General Foundry case. In that case the Court of Appeals of the Fourth Circuit held that the substance of the patentee's burner improvements was not embodied in the accused structure, and consequently there was no infringement, regardless of the breadth of the claim language. In this case the Court of Appeals of the Fourth Circuit has taken the opposite position and places a narrow interpretation on the claim language, to thereby exclude as an infringer one who has adopted the substance but not the form of the claimed invention.

Equally irrelevant is respondents' protest on page 5 of their brief that the Mayo apparatus was not copied from petitioners' Commercial Model D apparatus wherein the several associated burners are provided with a common hood. As both the preferred and alternate arrangements are fully described in the patent specification, it would seem to be immaterial whether or not this latter arrangement was on the market when the Mayo apparatus was introduced.

Also it is unimportant whether *all* the prior patents introduced in the Mayo-Hardy suit were offered by defendants in the case at bar. The so-called "important patent to Mims" (Appellant's App. 181), like the Brock and Rey-

nolds patents, shows nothing more than an oil heater in the middle of the barn.

The record in the Mayo-Hardy case is not here available, but it is plain from the opinions in the two cases that the Brock and Reynolds patents were in both cases chiefly relied upon as illustrative of the prior art, and that in the Mayo-Hardy case the second comer, Mayo, was accorded the status of a pioneer upon the mistaken belief that he was the first to successfully cure tobacco by the open flame method, while in this case the *earlier* patent to Smith, which describes and claims the apparatus which *did* solve that problem, is restricted in scope to the specific details shown and described.

It is therefore prayed that this petition be granted and the decision of the Court of Appeals for the Fourth Circuit reviewed and reversed.

Respectfully,

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Counsel for Petitioner.

New York, N. Y.,
November 15, 1950